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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/757,189

01/14/2004

Hubert Holderer

91306

3591

24628

7590

10/04/2006

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EXAMINER

PUNNOOSE, ROY M

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/757,189	<b>Applicant(s)</b> HOLDER ET AL.	
	<b>Examiner</b> Roy M. Punnoose	<b>Art Unit</b> 2877	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 23-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/14/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-22 in the reply filed on July 19, 2006 is acknowledged. The traversal is on the ground(s) that the two groups are so interlinked as to require a search to be conducted in identical classes and therefore a search and examination of the entire application can be made without serious burden. This is not found persuasive because the applicant further states, "applicant agrees that the two enumerated inventions may be independent and distinct."

In view of applicant's admission that the two enumerated inventions may be independent and distinct, the requirement is still deemed proper and is therefore made FINAL.

Further, there are several other pointers that indicate of two independent and distinct inventions. These are evidenced by the title (Optical Measuring System, and a Projection Objective), and numbered paragraphs [0001], [0010] and [0011] of this application now published as US 2004/027675 A1.

In view of applicant's implicit admission in the disclosure, which appears to indicate that the inventions are independent and distinct, **the restriction requirement is still deemed proper and is therefore made FINAL.**

2. Applicant is requested to cancel and/or withdraw from consideration the non-elected claims in response to this office action.

### *Specification*

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

*Arrangement of the Specification*

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading.

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS (if applicable).
- (c) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (d) BRIEF SUMMARY OF THE INVENTION.
- (e) BRIEF DESCRIPTION OF THE DRAWING(S).
- (f) DETAILED DESCRIPTION OF THE INVENTION.
- (g) CLAIM OR CLAIMS (commencing on a separate sheet).
- (h) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet and not more than 150 words).

4. In the instant application, the headings of several sections are missing. Appropriate correction is required.

5. The specification is objected to because:

- a. The “first object of the invention” is referenced to claim 1 (see numbered paragraph [0012] of this application now published as US 2004/027675 A1). This is improper. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. See 37 CFR 1.73 and MPEP § 608.01(d). Appropriate correction is required.
- b. The “second object of the invention” is referenced to claim 20 (see numbered paragraph [0019] of this application now published as US 2004/027675 A1). This is

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improper. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. See 37 CFR 1.73 and MPEP § 608.01(d). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

**2. The following is a quotation of the first paragraph of 35 U.S.C. 112:**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 is rejected because the limitations “location-determining measuring element” and the “angle-determining measuring element” are not defined in the specification. This lack of definition has made the claim vague and indefinite. Questions arise as what the “location-determining measuring element” represents and what the “angle-determining measuring element” represents in the claims, specification and the drawings. Appropriate correction is required.

Claims 2-21 are rejected for the same reasons of rejection of claim 1 above because as dependent claims, they contain and include the “location-determining measuring element” and the “angle-determining measuring element” limitations. Appropriate correction is required.

Claim 22 is rejected for the same reasons of rejection of claim 1 above because it has the “location-determining measuring element” and the “angle-determining measuring element” limitations. Appropriate correction is required.

**4. Because the above is a serious and significant defect, the claims and their respective limitations could not be searched and examined on their merits.**

**5. The following is a quotation of the second paragraph of 35 U.S.C. 112:**

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 20 recites the limitation "an objective" in line 1. There is insufficient antecedent basis for this limitation in the claim. An objective is not present in claim 1. Appropriate correction is required.

7. Claim 20 recites the limitation "an objective assembled according to claim 1" in line 1. There is insufficient antecedent basis for this limitation in the claim. An objective is not present in claim 1 and there are no assembly procedures in claim 1. Further, claim 20 does not further limit the structure of the device claimed in claim 1. Appropriate correction is required.

#### ***Drawings***

8. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “location-determining measuring element” and the “angle-determining measuring element” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Contact/Status Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

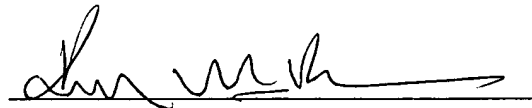
If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

October 01, 2006

  
**Roy M. Punnoose**  
Patent Examiner